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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/777,390	02/05/2001	Carl Hewitt	3COM-T3393	8391

7590 10/24/2003
WAGNER MURABITO & HAO LLP
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SAN JOSE, CA 95113

EXAMINER

NGUYEN, DUC M

ART UNIT PAPER NUMBER

2685

DATE MAILED: 10/24/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.
09/777,390

Applicant(s)
Hewitt et al

Examiner
Duc M. Nguyen

Art Unit
2685



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on _____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-25 is/are pending in the application.
- 4a) Of the above, claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-25 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
*See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☒ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s). 2 6) ☐ Other:

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DETAILED ACTION

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(e) the invention was described in-

(1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effect under this subsection of a national application published under section 122(b) only if the international application designating the United States was published under Article 21(2)(a) of such treaty in the English language; or

(2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that a patent shall not be deemed filed in the United States for the purposes of this subsection based on the filing of an international application filed under the treaty defined in section 351(a).

2. Claims 1-11, 16-21 are rejected under 35 U.S.C. 102(e) as being anticipated by

Mackintosh et al (US Patent Number 6,317,784).

Regarding claim 1, **Mackintosh** discloses a method for retrieving supplemental materials about programs playing at a broadcast radio station (see Figs. 5-6 and col. 8, line 33 - col. 11, line 31), which would include all the claimed limitations, wherein it is clear that in order to "retrieve" the supplemental materials, the requested information comprising ID codes would be transmitted by the user terminal.

Regarding claim 2, it is rejected for the same reason as set forth in claim 1 above. In addition, **Mackintosh** discloses the information is requested and retrieved via the Internet (see col. 10, lines 5-30).

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Regarding claim 3, it is rejected for the same reason as set forth in claim 1 above. In addition, **Mackintosh** discloses the identity of audio content consists of a unique radio appliance identifier (inherent feature to identify the request terminal) and an indicator used to identify the radio station (see col. 10, lines 18-23).

Regarding claim 4, it is rejected for the same reason as set forth in claim 1 above. In addition, **Mackintosh** discloses the identity of audio content consists of a unique radio appliance identifier (inherent feature to identify the request terminal) and a digitized form of the audio content (see col. 9, lines 8-33).

Regarding claims 5-7, they are rejected for the same reason as set forth in claim 1 above. In addition, **Mackintosh** discloses the requested information are details of a musical work, purchasing information and the title as claimed (see col. 9, lines 8-33 and col. 11, lines 1-8).

Regarding claims 8-11, they are rejected for the same reason as set forth in claim 1 above. In addition, **Mackintosh** discloses the audio content and requested information are details of a commercial transaction, purchasing information and the product as claimed (see col. 11, lines 1-40 and col. 13, line 15 - col. 14, line 65).

Regarding claims 16-17, they are rejected for the same reason as set forth in claim 1 above, wherein it is clear that **Mackintosh** would disclose a decoding process as claimed (inherent feature), in order to play the receiving audio content.

Regarding claims 18-21, they are interpreted and rejected for the same reason as set forth in claims 5-11 above.

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Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims **12-15, 22-25** are rejected under 35 U.S.C. 103(a) as being unpatentable by **Mackintosh** in view of **Alexander et al** (US Patent Number **6,177,931**).

Regarding claims **12-15, 22-24**, **Mackintosh** discloses all the claimed limitations, see claim 1 above, except for receiving user activities such as RF channel tuning or volume adjustment. However, since **Mackintosh** discloses the media player comprises features such as tuner button and volume button (see col. 12, lines 47-54), and since monitoring user activities such as channel tuning, channel switching and volume adjustment are well known in the art of program broadcasting as disclosed by **Alexander** (see col. 28, lines 30-52), it would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the above teaching of **Alexander** to **Mackintosh** as well, for monitoring user activities such as channel tuning or volume adjustment as claimed, so that advertisements can be effectively target to certain users based on analysis of viewer's actions.

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Regarding claim **25**, it is rejected for the same reason as set forth in claim **1** above. In addition, since **Mackintosh** discloses a personal computer (see col. 5, lines 30-37), it would have been obvious that such PC would comprise a software codec in order to convert the receiving digital data into audio for broadcasting audio data to the user of the personal computer.

Conclusion

5. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

- **DelSesto et al** (US Patent Number 6,530,082), Configurable monitoring of program viewership and usage of interactive application.

- **Rosser** (US Patent Number 6,446,261), Set top device for targeted electronic insertion of indicia into video.

- **Schein et al** (US Patent Number 6,263,501), System and method for linking television viewers with advertisers and broadcasters.

- **Boyer et al** (US Patent Number 6,268,849), Internet television program guide system with embedded real-time data.

- **Hudecek et al** (US Patent Number 6,289,207), Computerized radio receiver.

- **Pocock** (US Patent Number 6,314,577), Apparatus and method to generate and access broadcast information.

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- **Kiraly** (US Patent Number 6,249,810), Method and system for implementing an Internet radio device for receiving and/or transmitting media information.

6. **Any response to this action should be mailed to:**

Commissioner of Patents and Trademarks

Washington, D.C. 20231

or faxed to:

(703) 872-9314 (for formal communications intended for entry)

(for informal or draft communications, please label "PROPOSED" or "DRAFT")

Hand-delivered responses should be brought to Crystal Park II, 2121 Crystal Drive, Arlington VA, Sixth Floor (Receptionist).

Any inquiry concerning this communication or communications from the examiner should be directed to Duc M. Nguyen whose telephone number is (703) 306-4531, Monday-Thursday. Or to Edward Urban (Supervisor) whose telephone number is (703) 305-4385.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 305-4700.

Duc M. Nguyen



Oct 17, 2003